

### REMARKS

Applicant hereby adds new claims 28-39. Accordingly, claims 1-39 are pending in the present application.

Claims 1-3, 5-9, 12-17, 19-22, and 25-27 stand rejected under 35 USC 102(e) for anticipation by U.S. 6,629,134 to Hayward et al. Claims 4, 10-11, 18, and 23-24 stand rejected under 35 USC 103(a) for obviousness over Hayward in view of U.S. Patent No. 6,317,570 to Uchida et al.

Applicant respectfully traverses the rejections and urges allowance of the present application.

Applicant has amended the specification to delete the hyperlink. Applicant respectfully requests approval of the specification.

Referring to the anticipation rejections, Applicant notes the requirements of MPEP §2131 (8<sup>th</sup> ed., rev. 2), which states that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. The **identical invention** must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). **The elements must be arranged as required by the claim.** *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Referring to claim 1, the Office identifies teachings in cols. 4 and 7 of Hayward as allegedly disclosing the claimed downloading. Applicant has failed to identify any teachings in cols. 4 and 7 of downloading a *configuration plug-in* as positively claimed in claim 1. In fact, Applicant has electronically searched Hayward and failed to uncover any recitations to "plug" or "plug-in" as claimed. Positively-recited limitations of claim 1 are not disclosed nor suggested by the prior art and claim 1 is allowable for at least this reason.

Also, the teachings at col. 4, lines 12+ of Hayward disclose "a file of additional information" is directed to the peripheral after online registration. The teachings in col. 4 make clear that the file refers to *product support information* which may not be fairly interpreted to disclose or suggest the *configuration plug-in* or *configuration data each including user-specified information* as defined in claim 1. Further, there is no teaching in Hayward that the *diagnostic* module of col. 7, lines 50+ performs any *configuration operations* to be interpreted as a configuration plug-in or configuration data. Applicant submits that information regarding product

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Amendment A

support and performing diagnostics fail to disclose or suggest any teachings with respect to the claimed configuration plug-in or configuration data.

In addition, Applicant has been unable to locate any teachings in Hayward that the product support information or diagnostic module include any user-specified information. The teachings of cols. 4 and 7 of Hayward are void of disclosing downloading a configuration plug-in or configuration data including user-specified information as positively-claimed.

For at least the above-compelling reasons, Hayward fails to teach or suggest the claimed downloading and claim 1 is allowable for at least this reason.

Claim 1 also recites configuring the hard copy output engine using the downloaded data. The teachings at col. 7, lines 48+ of Hayward relied upon by the Office fail to disclose the claimed *configuring*. More specifically, the teachings relied upon by the Office merely state that *the very specific sub-modules test each part of the machine*. Performing diagnostics including testing may not be fairly interpreted to disclose or suggest the claimed *configuring*. Accordingly, the claimed configuring is not disclosed nor suggested by the prior art and claim 1 is allowable for this additional reason.

If claim 1 is not allowed, Applicant respectfully requests clarification of any rejection in a non-final Action so Applicant may appropriately respond. In particular, applicants have identified above numerous claimed limitations which are not disclosed nor suggested by the teachings of the prior art identified by the Office. In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable*. Applicant respectfully requests clarification of the rejections with respect to specific references and specific reference teachings which allegedly disclose at least the limitations of configuration plug-in, configuration data, user-

specified information and configuring of the hard copy output engine so Applicant may appropriately respond during the prosecution of this application.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 2, it is recited that the *configuration plug-in and configuration data include data prepared by determining user thresholds for consumables*. The Office relies upon teachings in col. 8, lines 38-44 of Hayward as allegedly disclosing the claimed determining user thresholds. However, the identified teachings merely state that a peripheral condition is used to indicate when a consumable has been exhausted or reached a predetermined threshold. The mere teachings defining a threshold are void of disclosing or suggesting preparation of the configuration plug-in and configuration data by determining user thresholds in combination with the downloading as positively claimed. Positively recited limitations of claim 2 are not disclosed nor suggested by the prior art and claim 2 is allowable for at least this reason.

Referring to independent claim 8, the claimed code configured to cause a processor to download data including a *configuration plug-in and configuration data each including user-specified information* and to *configure a hard copy output engine* using the downloaded data recite numerous limitations which are not disclosed nor suggested by the prior art. Applicant has failed to uncover any teachings in Hayward of a plug-in, configuration operations, a configuration plug-in and configuration data each including user-specified information, or configuration of the hard copy output engine using the downloaded data as claimed. Numerous limitations of claim 8 are not disclosed nor suggested by the prior art and claim 8 is allowable for at least this reason.

The claims which depend from independent claim 8 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to independent claim 15, the claimed processing circuitry configured to employ the software module to *download data including a*

configuration plug-in and configuration data each including user-specified information and to configure a hard copy output engine using the downloaded data recite numerous limitations which are not disclosed nor suggested by the prior art. Applicant has failed to uncover any teachings in the prior art of a plug-in, configuration operations, a configuration plug-in and configuration data each including user-specified information, or configuration of the hard copy output engine using the downloaded data as claimed. Numerous limitations of claim 15 are not disclosed nor suggested by the prior art and claim 15 is allowable for at least this reason.

The claims which depend from independent claim 15 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to independent claim 21, the instructions which cause a processor to download data including a configuration plug-in and configuration data each including user-specified information and to configure a hard copy output engine using the downloaded data recite numerous limitations which are not disclosed nor suggested by the prior art. Applicant has failed to uncover any teaching of a plug-in, configuration operations, a configuration plug-in and configuration data including user-specified information, or configuration of the hard copy output engine using the downloaded data as claimed. Numerous limitations of claim 21 are not disclosed nor suggested by the prior art and claim 21 is allowable for at least this reason.

Applicant hereby adds new claims 28-39 which are supported at least by Figs. 1-3 and 6 and the associated specification teachings of the originally filed application.

Applicant hereby submits a copy of an IDS mailed June 18, 2003 and form PTO-1449 which has not been initialed by the Examiner. Applicant respectfully requests initialization of the form and return of the form to Applicant.

Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is

available for telephone consultation at any time during normal business hours  
(Pacific Time Zone).

Respectfully submitted,

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By:



James D. Shaurette

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Date: 6/6/05